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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/091,735	06/24/1998	IAN DUNCAN BRAMHILL	36-1230	5276

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/091,735

Applicant(s)
Bramhill et al.

Examiner
Cuong H. Nguyen

Art Unit
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 16, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12, 14-18, 21-26, and 28-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 14-18, 21-26, and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the IDS and the amendment received on 11/16/2001; which papers have been placed of record.
2. Claims 1-30 are pending in this application; claims 9-11, 13, 19-20, and 27 have been canceled; claims 28-31 have been added.

Response:

3. Applicants' arguments have been fully considered but they are not persuasive with previous cited references and further in view of submitted IDS on "IMPRIMATUR" references for 35 U.S.C. § 103(a) rejections. All the answers to the arguments on pp.10-13 of the amendment received on 6/20/2000 are within court case decisions that the examiner submits as followings:

4. In re Hiniker Co., 47 USPQ2d 1523, 1529 (Fed. Cir. 1998)), the court rules: "The name of the game is the claim."

5. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims". See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill

to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations. See Giles Sutherland Rich, *Extend of Protection and Interpretation of Claims -- American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

Re. to argument of motivation to Combine References

(allegation of peace-meal limitations):

7. *In re Fine*, 5 USPQ2d 1596 (CA FC 1988), the court ruled: The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

8. *In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967), the court ruled: "Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be

done, other than to obtain the expected superior beneficial results."

9. *In re Beattie*, 24 USPQ2d 1040 (CA FC 1992), the court ruled:

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

10. About argument of non-obviousness based on the number of references: *In re Gorman*, 18 USPQ2d 1885 (CA FC), the court ruled: "Patent and Trademark Office's reliance on teachings of large number of references in rejecting patent application for obviousness does not, without more, weigh against holding of obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field."

The examiner submits that base on In re Hiniker, the cited references became at least analogous applications in data processing areas of their endeavour in achieving pending claimed results; and the examiner sees there is nothing inappropriate to cite related U.S. patents as references because they actually are related to claims' subject matters (US Classification for these references).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8, 12, 14-18, 21-26, and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Yourdon**, in view of **Dean et al.**, **Wobber et al.** (U.S. Pat.5,235,642), **Richardson** (PCT WO-A-9407204), further in view of the IDS submitted on 11/16/02 on "IMPRIMATUR".

Yourdon suggests ideas of dealing about security on the Internet (see **Yourdon** pg. 28, cols.1-2 about **Security**), he submits that applications should ensure "secure access to functionality and data, as well as secure transmission of data across the Internet". Adding digital signatures to

applets was contemplated, such that a user can be sure of the source and origin of a downloaded applets. As typical for a client server application, a password may be asked "to determine the end user's authorization to invoke certain functionalities of access certain data", and "the application will interact with the browser to encrypt/decrypt transmissions between the client and the server". **Yourdon** further proposes to integrate encryption packages like PGP into Internet applications and achieve higher security with a public key password system.

Dean et al. contribute ideas about security issues raised in Web browsers such as HotJava and Netscape by server supplied code constituted by Java applets downloaded to and run inside the Web browsers. "In Netscape, Java applets can name only those functions and variables explicitly exported to the Java subsystem". **Dean** et al. further suggest that Java would be more secure if encryption was used.

Both **Yourdon** and **Dean** et al. talk about encryption, and hashing has been known in the art as also a security measure ensuring integrity of data. **Yourdon** also suggests hashing by proposing to add signatures to information downloaded from the Web such that the receiving side can be sure of its source and origin, thus of its integrity.

Both **Yourdon** and **Dean** et al. obviously suggest method and systems for ensuring security of functionality and data

in a client-server environment - in particular for Internet users. However they do not expressly address a specific problem of protecting from copying data, and doing data authentication which have been downloaded from a server to a client.

However, **Wobber** et al. obviously propose to achieve access control using copies of clients credentials cached at the server for future use. Their security system includes a computer at each node of the distributed system with a trusted computing base that includes an authentication agent for authenticating requests received from principals at other nodes in the system. Requests are transmitted to servers as messages that include a first identifier (i.e. Auth ID) provided by the requester and a second identifier (called the subchannel value) provided by the requester and a second identifier (called the subchannel value) provided by the authentication agent of the requester node. Each server process has an associated local cache that identifies requesters whose previous request messages have been authenticated. When a request is received, the server checks the request's two identifiers against the entries in its local cache. If there is a match, the request is known to be authentic without having to obtain authentication from the requester's node.

One with skills in the art would need no inventive activity to infer from the teachings of **Yourdon** ("to

determine the end user's authorization to invoke certain functionalities of access certain data", and Dean et al. ("applets can name only those functions and variables explicitly exported to the Java sub-system", at least when taken in combination, that a solution consists in selectively controlling copying functions of the client in respect of the downloaded data, hence arriving at the subject matter of claim 1.

12. As per claims 5-6, 17: Yourdon, Richardson, and Wobber et al. also teaches about password, public key, password system that claimed (in claims 5, 6, 17).

Therefore, the same reasoning applies for identifying/authorizing/registering a client to a server because these above input must be provided for accessing a computer system to achieve these steps.

13. As per claims 7-8: Gosling (EP 0718761 A1) also discloses of downloading of a program. This feature has been well-known in the art.

14. As per claims 12, 14, 16: The examiner submits that Bender et al. in provided reference titled "Techniques for data hiding" disclose about steganographically marking data (claim 16); this feature is also well-known in the art. The Official Notice is taken that the feature of claims 12, and the use of a cryptographic key are well-known in the art.

The examiner further notes that "IMPRIMATUR" references were proper for 35 USC 103(a) rejections upon examination of

pending claimed languages. Claim 15 is objected because it is dependent on a rejected based claim.

Conclusion

15. Claims 1-8, 12, 14-18, 21-26, 28-31 are unpatentable.

16. The prior submitted references are considered pertinent to applicants' disclosure.

17. Remarks:

A. In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981)

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

B. Ex parte Rubin, 5 USPQ2d 1461 (BdPatApp&Int 1987):

Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

C. In re Susi, 169 USPQ 423 (CCPA 1971): Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

D. In re Heck, 216 USPQ 1038 (Fed. Cir. 1983): "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

E. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

F. MPEP 2113 Product-by-Process Claims:

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

G. The functions perform on this apparatus/system needs internal dedicated software that allows it to store, organize, retrieve, and transfer .. etc., as computers cannot perform storage and retrieval functions without software.

H. The examiner submits that the reasons for rejection are inherent and obvious v.s. cited prior arts. One of ordinary skills in the art at the time of the invention would have found these claim's limitations would be very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited inventions have been described in connection with specific preferred embodiments, it should be understood that invention as claimed should not be unduly limited to such specific embodiments

I. The examiner also submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:15 AM-3:15 PM.

Any response to this action should be mailed to:

Serial Number: 09/0735
Art Unit: 2165

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 746-7238 (after Final)

(703) 746-7239 (Official)

Or: (703) 746-5572/746-7240 (for informal or draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park
II, 2121 Crystal Drive, Arlington. VA., 4th. Floor
(Receptionist).

Any inquiry of a general nature or relating to the
status of this application should be directed to the Group
receptionist whose telephone number is (703) 305-3900.

Cuong Nguyen

Primary Examiner
January 25, 2002